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EXAMINER

PARRY, CHRISTOPHER L

ART UNIT

PAPER NUMBER

2421

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/594,152	<b>Applicant(s)</b> IMANAKA, RYOICHI	
	<b>Examiner</b> CHRIS PARRY	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 4 and 7-13 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 14, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. The indicated allowability of claims 1, 2, 5, 6, 14, 17 and 18 is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 14, 17, and 18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lett et al. "Lett" (USPN 5,592,551) in view of Horton et al. "Horton" (USPN 4,945,563).

Regarding Claim 1, Lett discloses an information on demand system (figure 1) (i.e., subscription television system shown in figure 1 provides PPV programs and

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NVOD to authorized subscribers who purchased the programs; see Abstract)  
comprising:

a server apparatus (10 and 12 – figures 1 and 2) for providing information according to a request from a subscriber (i.e., user's request for PPV or NVOD is transmitted from RF module 154 within terminal 14 to system manager 22 via RF processor 34 in cable headend 12 and upon authorization of system manager 22, headend 12 provides terminal 14 with requested program) (Col. 10, lines 49-60, Col. 4, lines 41-67, and Col. 14, lines 38-49);

display means (20 – figure 2) for display said information provided by said server apparatus (Col. 8, lines 55-67);

recording means (18 – figure 2) for recording said information provided by said server apparatus (Col. 4, lines 26-32, Col. 14, lines 50-67, and Col. 12, lines 21-25);  
and

wherein in a different amount is charged to said subscriber among a) in the case in which said information is provided to said display means (i.e., the user may watch a “free” preview of a PPV event) and b) in the case in which said information is provided to said recording means (i.e., user must purchase the event and is charged a fee in order to record the program) (Col. 14, lines 38-67 and Col. 4, lines 41-67).

However, Lett fails to specifically disclose wherein in a different amount is charged to said subscriber in the case in which said information is provided to said display means and to said recording means.

In an analogous art, Horton discloses subscriber's may preview a movie free-of-charge, may be charged a certain amount for viewing the movie and a different amount is charged when the movie is ordered for recording (Col. 2, lines 25-65; Col. 3, lines 39-56, and Col. 4, lines 20-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lett to include wherein in a different amount is charged to said subscriber in the case in which said information is provided to said display means and to said recording means as taught by Horton for the benefit of charging a subscriber a fee to view the program and charging an additional fee to record the program that is equal to the purchasing price of a cassette of a program.

Regarding Claim 2, Lett discloses an information on demand system (figure 1) (i.e., subscription television system shown in figure 1 provides PPV programs and NVOD to authorized subscribers who purchased the programs; see Abstract) comprising:

an information providing means (10 and 12 – figures 1 and 2) for providing information according to a request from a subscriber (i.e., user's request for PPV or NVOD is transmitted from RF module 154 within terminal 14 to system manager 22 via RF processor 34 in cable headend 12) (Col. 10, lines 49-60, Col. 4, lines 41-67, and Col. 14, lines 38-49);

information receiving means (100 – figure 3) for receiving said information provided by said information providing means (i.e., upon authorization of system

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manager 22, headend 12 provides terminal 14 with requested program) (Col. 7, lines 20-53, Col. 10, lines 49-60, and Col. 4, lines 41-67);

display means (20 – figure 2) for displaying a further information signal output from said information receiving means (Col. 8, lines 55-67);

recording means (18 – figure 2) for recording said further information signal of said information receiving means (Col. 4, lines 26-32, Col. 14, lines 50-67, and Col. 12, lines 21-25); and

subscriber mode discrimination means (128 – figure 3) for discrimination whether said further information signal of said information receiving means is provided to one of said display means (20 – figure 2) and said recording means (18 – figure 2) (Col. 9, lines 1-4 and lines 43-65 and Col. 14, lines 39-67).

However, Lett fails to specifically disclose charging means for charging a different amount among a) in the case in which said information is provided to said display means b) in the case in which said information is provided to said recording means and (c) in the case in which said further information is provided to said display means and to said recording means according to an output of said subscriber mode discriminating means and charge registering means for registering charge data output from said charging means.

In an analogous art, Horton discloses a system (figure 1) comprising:

subscriber mode discrimination means (30 – figure 1) for discriminating whether said further information signal of said information receiving means (26 – figure 1) is

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provided to one of said display means (42 – figure 1) and said recording means (44 – figure 1) (Col. 3, lines 37-53 and Col. 4, lines 20-34);

charging means (28 – figure 1) for charging a different amount among a) in the case in which said further information is provided to said display means (i.e., the user pays a first fee to view only) b) in the case in which said further information is provided to said recording means (i.e., the user tapes for free) (c) in the case in which said further information is provided to said display means and to said recording means according to an output of said subscriber mode discriminating means (i.e., subscribers may pay a second higher fee to view and record) (Col. 2, lines 25-65; Col. 3, lines 39-56, and Col. 4, lines 20-34); and

charge registering means (46 – figure 1) for accumulating an amount output for said charging means (Col. 3, lines 53-60).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lett to include wherein in a different amount is charged to said subscriber depending on the selected mode of viewing as taught by Horton for the benefit of providing a system that efficiently bills a subscriber only for programs that are viewed or viewed and taped.

Regarding Claim 5, Lett discloses a subscriber apparatus (14 – figures 1-3) comprising:

information receiving means (100 – figure 3) for receiving a provided information according to a request from a subscriber (i.e., user's request for PPV or NVOD is

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transmitted from RF module 154 within terminal 14 to system manager 22 via RF processor 34 in cable headend 12 and upon authorization of system manager 22, headend 12 provides terminal 14 with requested program) (Col. 7, lines 20-53, Col. 10, lines 49-60, and Col. 4, lines 41-67);

subscriber mode discrimination means (128 – figure 3) for discriminating whether a further information signal output from said information receiving means is provided a) to a display means (20 – figure 2) and (b) to a recording means (18 – figure 2) (Col. 9, lines 1-4 and lines 43-65 and Col. 14, lines 39-67); and

recording means (18 – figure 2) for recording said information provided by said server apparatus (Col. 4, lines 26-32, Col. 14, lines 50-67, and Col. 12, lines 21-25).

However, Lett fails to specifically disclose charging means for charging a different amount among a) in the case in which said information is provided to said display means b) in the case in which said information is provided to said recording means and (c) in the case in which said further information is provided to said display means and to said recording means according to an output of said subscriber mode discriminating means and charge registering means for registering charge data output from said charging means.

In an analogous art, Horton discloses a subscriber apparatus (20 – figure 1) comprising:

information receiving means (26 – figure 1, Col. 3, lines 37-39);

subscriber mode discrimination means (30 – figure 1) for discriminating whether a further information signal output from said information receiving means [26] is



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provided (a) to a display means (42 – figure 1), (b) to a recording means (44 – figure 1), or (c) to both said display means and said recording means [42 and 44] (Col. 3, lines 37-53 and Col. 4, lines 20-34);

charging means (28 – figure 1) for charging a different amount among a) in the case in which said further information is provided to said display means (i.e., the user pays a first fee to view only) b) in the case in which said further information is provided to said recording means (i.e., the user tapes for free) and (c) in the case in which said further information is provided to said display means and to said recording means according to an output of said subscriber mode discriminating means (i.e., subscribers may pay a second higher fee to view and record) (Col. 2, lines 25-65; Col. 3, lines 39-56, and Col. 4, lines 20-34); and

charge registering means (46 – figure 1) for accumulating an amount output for said charging means (Col. 3, lines 53-60).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lett to include wherein in a different amount is charged to said subscriber depending on the selected mode of viewing as taught by Horton for the benefit of providing a system that efficiently bills a subscriber only for programs that are viewed or viewed and taped.

As for Claim 6, Lett and Horton disclose, in particular Horton teaches wherein the charge registering apparatus means [46] periodically information the subscriber's charge to a server (Col. 3, lines 56-60).

5. Claims 14, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lett et al. "Lett" (USPN 5,592,551) in view of Yoo (USPN 5,497,240).

Regarding Claim 14, Lett discloses an information on demand system (figure 1) (i.e., subscription television system shown in figure 1 provides PPV programs and NVOD to authorized subscribers who purchased the programs; see Abstract) comprising:

a server apparatus (10 and 12 – figures 1 and 2) for providing information responsive to a request from a terminal (14 – figures 1 and 2) (i.e., user's request for PPV or NVOD is transmitted from RF module 154 within terminal 14 to system manager 22 via RF processor 34 in cable headend 12 and upon authorization of system manager 22, headend 12 provides terminal 14 with requested program) (Col. 10, lines 49-60, Col. 4, lines 41-67, and Col. 14, lines 38-49);

a recording reproducing apparatus (18 – figure 2) for reproducing the information into a recording medium (i.e., video cassette tape) (Col. 4, lines 26-32, Col. 14, lines 50-67, and Col. 12, lines 21-25); and

charging means (i.e., system manager 22 controls billing for PPV and NVOD events) for charging a different amount to said terminal [14] when a) said terminal receives the information (i.e., the user may watch a "free" preview of a PPV event) or b) said recording reproducing apparatus records the information (i.e., user must purchase the event and is charged a fee in order to record the program) (Col. 14, lines 38-67 and Col. 4, lines 41-67).

Lett discloses storing authorization data or "unique ID" in non-volatile memory within secure microprocessor 136 which permits the user to view or record the selected PPV or NVOD program (Col. 9, lines 27-42 and Col. 4, lines 41-54). However, Lett fails to specifically disclose wherein when a unique identification (ID) information is detected in said recording medium, the information provided from said server is recorded into said recording medium.

In an analogous art, Yoo discloses wherein when a unique identification (ID) information (i.e., tape ID code) is detected in said recording medium (i.e., video tape inserted in VCR), the information provided from said server is recorded into said recording medium (i.e., a subscriber video library system that detects that identity of a recording medium before recording, in order to determine whether a new or old tape has been inserted) (figure 2; Col. 4, lines 27-47 and Col. 5, lines 1-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lett to include wherein when a unique identification (ID) information is detected in said recording medium, the information provided from said server is recorded into said recording medium as taught by Yoo for the benefit of ensuring that the tape is properly indexed according the method being used by the recording system, (i.e., the video library system as disclosed by Yoo, Col. 2, lines 21-62).

Regarding Claim 17, Lett discloses a recording medium (i.e., video cassette tape) used for an information on demand system (figure 1) (i.e., subscription television system shown in figure 1 provides PPV programs and NVOD to authorized subscribers

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who purchased the programs; see Abstract), said information on demand system comprising:

a server apparatus (10 and 12 – figures 1 and 2) for providing information responsive to a request from a terminal (14 – figures 1 and 2) (i.e., user's request for PPV or NVOD is transmitted from RF module 154 within terminal 14 to system manager 22 via RF processor 34 in cable headend 12 and upon authorization of system manager 22, headend 12 provides terminal 14 with requested program) (Col. 10, lines 49-60, Col. 4, lines 41-67, and Col. 14, lines 38-49);

a recording reproducing apparatus (18 – figure 2) for recording the information into a recording medium (i.e., video cassette tape) (Col. 4, lines 26-32, Col. 14, lines 50-67, and Col. 12, lines 21-25); and

a charging means (i.e., system manager 22 controls billing for PPV and NVOD events) for charging a different amount to said terminal [14] when a) when said terminal receives the information (i.e., the user may watch a "free" preview of a PPV event) or b) said recording reproducing apparatus records the information (i.e., user must purchase the event and is charged a fee in order to record the program) (Col. 14, lines 38-67 and Col. 4, lines 41-67).

Lett discloses storing authorization data or "unique ID" in non-volatile memory within secure microprocessor 136 which permits the user to view or record the selected PPV or NVOD program (Col. 9, lines 27-42 and Col. 4, lines 41-54). However, Lett fails to specifically disclose wherein when a unique identification (ID) information is detected

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in said recording medium, the information provided from said server is recorded into said recording medium.

In an analogous art, Yoo discloses wherein when a unique identification (ID) information (i.e., tape ID code) is detected in said recording medium (i.e., video tape inserted in VCR), the information provided from said server is recorded into said recording medium (i.e., a subscriber video library system that detects that identity of a recording medium before recording, in order to determine whether a new or old tape has been inserted) (figure 2; Col. 4, lines 27-47 and Col. 5, lines 1-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lett to include wherein when a unique identification (ID) information is detected in said recording medium, the information provided from said server is recorded into said recording medium as taught by Yoo for the benefit of ensuring that the tape is properly indexed according the method being used by the recording system, (i.e., the video library system as disclosed by Yoo, Col. 2, lines 21-62).

Regarding Claim 18, Lett discloses a method for providing information on demand (i.e., subscription television system shown in figure 1 provides PPV programs and NVOD to authorized subscribers who purchased the programs; Abstract) comprising the steps of:

providing information by a server apparatus (10 and 12 – figures 1 and 2) responsive to a request from a terminal (14 – figures 1 and 2) (i.e., user's request for PPV or NVOD is transmitted from RF module 154 within terminal 14 to system manager

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22 via RF processor 34 in cable headend 12 and upon authorization of system manager 22, headend 12 provides terminal 14 with requested program) (Col. 10, lines 49-60, Col. 4, lines 41-67, and Col. 14, lines 38-49);

receiving the information by said terminal [14] from said server apparatus [10 and 12] upon authorization of system manager 22, headend 12 provides terminal 14 with requested program) (Col. 7, lines 19-53 and Col. 4, lines 41-67);

recording the information onto a recording medium (i.e., video cassette tape) (figures 1 and 2; Col. 4, lines 26-32, Col. 14, lines 50-67, and Col. 12, lines 21-25); and

charging a different amount based on one of a) whether the information is received by the terminal (i.e., the user may watch a “free” preview of a PPV event) or b) whether the information is recorded on the recording medium (i.e., user must purchase the event and is charged a fee in order to record the program) (Col. 14, lines 38-67 and Col. 4, lines 41-67).

Lett discloses storing authorization data or “unique ID” in non-volatile memory within secure microprocessor 136 which permits the user to view or record the selected PPV or NVOD program (Col. 9, lines 27-42 and Col. 4, lines 41-54). However, Lett fails to specifically disclose recording the information onto a recording medium when a unique identification (ID) information is detected in said recording medium.

In an analogous art, Yoo discloses recording the information onto a recording medium when a unique identification (ID) information is detected in said recording medium (i.e., a subscriber video library system that detects that identity of a recording medium before recording, in order to determine whether a new or old tape has been

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inserted) (figure 2; Col. 4, lines 27-47 and Col. 5, lines 1-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lett to include recording the information onto a recording medium when a unique identification (ID) information is detected in said recording medium as taught by Yoo for the benefit of ensuring that the tape is properly indexed according the method being used by the recording system, (i.e., the video library system as disclosed by Yoo, Col. 2, lines 21-62).

#### ***Allowable Subject Matter***

6. Claims 3, 4, and 7-13 are allowed.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS PARRY whose telephone number is (571) 272-8328. The examiner can normally be reached on Monday through Friday, 8:00 AM EST to 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN MILLER can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/  
Supervisory Patent Examiner, Art Unit 2421

CHRIS PARRY  
Examiner  
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